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Paper No.

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In re Application of :
John I. M. Choate :
Application No. 10/780,476 :
Filing Date: February 16, 2004 :
Title: APPARATUS THAT IMPROVES :
DISCOVERY OF CANCER MASS, AND :
REDUCES INFLAMMATION - ONSET OF :
SYMPTOMS OF CARPAL TUNNEL :
SYNDROME OR ARTHRITIS - TACTILE :
DEFICIT OF FINGERS, AND :
INCREASES DISCOVERY OF FOREIGN :
MASS IN BREAST AND OTHER SELF :
EXAMINATIONS :

OFFICE OF PETITIONS

DECISION ON RENEWED PETITION
UNDER 37 C.F.R. § 1.181

This is a decision on the renewed petition filed on December 14, 2007, pursuant to 37 C.F.R. § 1.181, requesting that the holding of abandonment in the above-identified application be withdrawn.

Background

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed October 13, 2006, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on January 14, 2007. A notice of abandonment was mailed on September 12, 2007.

Procedural History

A petition pursuant to 37 C.F.R. § 1.183 was filed on April 16, 2007, which was dismissed via the mailing of a decision on August 6, 2007 for failure to include the required petition fee.

An original petition pursuant to 37 C.F.R. § 1.181 was filed on October 1, 2007, and was dismissed via the mailing of a decision on October 26, 2007.

Relevant Portions of The C.F.R.

37 C.F.R. § 1.8 sets forth, *in pertinent part*:

(a) Except in the situations enumerated in paragraph (a)(2) of this section or as otherwise expressly excluded in this chapter, correspondence required to be filed in the U.S. Patent and Trademark Office within a set period of time will be considered as being timely filed if the procedure described in this section is followed. The actual date of receipt will be used for all other purposes.

(1) Correspondence will be considered as being timely filed if:

(i) The correspondence is mailed or transmitted prior to expiration of the set period of time by being:

(A) Addressed as set out in § 1.1(a) and deposited with the U.S. Postal Service with sufficient postage as first class mail; or

(B) Transmitted by facsimile to the Patent and Trademark Office in accordance with § 1.6(d); and

(ii) The correspondence includes a certificate for each piece of correspondence stating the date of deposit or transmission. The person signing the certificate should have reasonable basis to expect that the correspondence would be mailed or transmitted on or before the date indicated.

...

(b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the U.S. Patent and Trademark Office after a reasonable amount of time has elapsed from the time of mailing or transmitting of the correspondence, or after the application is held to be abandoned, or after the proceeding is dismissed, terminated, or decided with prejudice, the correspondence will be considered timely if the party who forwarded such correspondence:

(1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;

(2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and

(3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by

Decision on Renewed Petition Pursuant to 37 C.F.R. § 1.181

facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

ANALYSIS

The showing in this renewed petition is not sufficient to withdraw the holding of abandonment.

The decision on the original petition pursuant to 37 C.F.R. § 1.181 set forth, *in pertinent part*:

A non-final Office action was mailed on October 13, 2006, which set a shortened statutory period for reply of three months. As such, the maximum extendable period for reply expired at midnight on April 13, 2007.

The electronic record has been reviewed, and it is noted that on April 16, 2007, an amendment, a three-month extension of time a request for the Office to waive the extension of time requirement, and the aforementioned Petition pursuant to Rule § 1.183 were received in the Office.

Each of these papers has been reviewed, and it does not appear that a certificate of mailing was placed on any of them.

...

Certificate of mailing practice provides a mechanism by which Applicants may evince that a paper was timely submitted to the Office, in the event that the correspondence is not received. Petitioner's submission of April 16, 2007 has been reviewed, and it does not appear to contain a certificate of mailing. As such, it does not appear that Petitioner can comply with 37 C.F.R. §1.8(b)(2).

In the original petition pursuant to 37 C.F.R. § 1.181, Petitioner included the following statement:

I certify On April 12, 2007, I mailed the Response to the October 6, 2006, to the USPTO, by first class postage prepaid certified mail. I attach to this fax the certified mail receipt...

On renewed petition, Petitioner has alleged "there is nothing in the mailing rule that (sic) the certificate need be **simultaneous** (emphasis included)..." Consequently, Petitioner created a statement subsequent to the mailing described therein, and wishes to use this statement as a certificate of mailing to evince that the paper described therein was timely submitted to the Office.

Petitioner's interpretation of the Rule does not appear to be accurate.

The relevant portion of 37 C.F.R. § 1.8(a)(1) provides that that "correspondence will be considered as being timely filed" if the following four conditions are met:

- (i) The correspondence is mailed prior to expiration of the set period of time:
- (ii) The correspondence is addressed as set out in 37 C.F.R. § 1.1(a):
- (iii) The correspondence is deposited with the U.S. Postal Service with sufficient postage as first class mail, and;
- (iv) The correspondence **includes** a certificate for each piece of correspondence stating the date of deposit.

The rule requires that the mailing must include a certificate of mailing for each piece of correspondence contained therein. It follows that a certificate of mailing that is not created until after the mailing has taken place cannot be included with said mailing, as required by this Rule.

The mailing of April 12, 2007 (received on April 16, 2007) did not contain a certificate of mailing, because the statement that Petitioner wishes to use as a certificate of mailing was not in existence until its creation almost six months later.

CONCLUSION

Any reply must be submitted within **TWO MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. § 1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. § 1.181". This is not a final agency action within the meaning of 5 U.S.C § 704.

Thereafter, there will be no further reconsideration of this matter^{1, 2}.

1 For more than a century, punctuality and due diligence, equally with good faith, have been deemed essential requisites to the success of those who seek to obtain the special privileges of the patent law, and they are demanded in the interest of the public and for the protection of rival inventors. See: Porter v. Loudon, 7 App.D.C. 64 (C.A.D.C. 1895), citing Wollensak v. Sargent, 151 U.S. 221, 228, 38 L. Ed. 137, 14 S. Ct. 291 (1894). An invention benefits no one unless it is made public, and the rule of diligence should be so applied as to encourage reasonable promptness in conferring this benefit upon the public. Automatic Electric Co. v. Dyson, 52 App. D.C. 82; 281 F. 586 (C.A.D.C. 1922). Generally, 35 U.S.C. §6; 37 C.F.R. §§1.181, 182, 183.

2 If, on the second request for reconsideration, Petitioner fails to satisfy the showings burden required: (a) the resulting decision may be one viewed as

Petitioner's only relief is a petition under 37 C.F.R. § 1.137, and - having been made aware of this reality - any delay in promptly seeking relief under 37 C.F.R. § 1.137 may be considered evidence of intentional delay and an absolute bar to revival.

Any response to this decision should indicate in a prominent manner that the attorney handling this matter is Paul Shanowski, and may be submitted by mail³, hand-delivery⁴, or facsimile⁵. Registered users of EFS-Web may alternatively submit a response to this decision via EFS-Web⁶.

If responding by mail, Petitioner is advised not to place the undersigned's name on the envelope. Only the information that appears in the footnote should be included - adding anything else to the address will delay the delivery of the response to the undersigned.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225⁷. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanowski/
Paul Shanowski
Senior Attorney
Office of Petitions

final agency action; and (b) provisions for reconsideration, such as those at 37 C.F.R. §1.137(e), will not apply to that decision.

3 Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

4 Customer Window, Randolph Building, 401 Dulaney Street, Alexandria, VA, 22314.

5 (571) 273-8300- please note this is a central facsimile number.

6 <https://sportal.uspto.gov/authenticate/authenticateuserlocalepf.html>

7 Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any further action(s) of Petitioner.